

REMARKS

This application has been reviewed in light of the final Office Action dated March 21, 2006. Claims 1, 3-11, 30-32, 37, and 39-44 remain presented for examination. Claims 1, 10, 11, and 37 are in independent form. Favorable reconsideration is respectfully requested in view of the follow comments.

Claims 1, 3, 4, 8, 30, 37-40, and 44 have been rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 6,115,157 A (*Barnard et al.*) in view of U.S. Patent No. 5,289,474 A (*Purcell et al.*). Claims 5, 6, 41, and 42 have been rejected under 35 U.S.C. 103(a) as being unpatentable over *Barnard et al.* in view of *Purcell et al.*, and further in view of U.S. Patent No. 5,619,489 (*Chang et al.*). Claims 7, 9, and 43 have been rejected under 35 U.S.C. 103(a) as being unpatentable over *Barnard et al.* in view of *Purcell et al.*, and further in view of U.S. Patent No. 6,108,113 A (*Fee*) and U.S. Patent No. 6,504,630 B1 (*Czarnocha et al.*). Claims 31 and 32 have been rejected under 35 U.S.C. 103(a) as being unpatentable over *Barnard et al.* in view of *Purcell et al.*, and further in view of U.S. Patent No. 5,060,226 A (*Gewin et al.*). Claim 10 has been rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 5,619,489 A (*Chang et al.*) in view of *Purcell et al.* Claim 11 has been rejected under 35 U.S.C. 103(a) as being unpatentable over *Barnard et al.* in view of *Purcell et al.* and *Fee*.

The rejections of independent Claims 1, 10, and 11 will now be addressed.

Each of the independent Claims 1, 10, and 11 recite, in part, that the transponder includes a frame memory pre-stored with at least three predefined test

frames, each test frame being an error frame or a valid frame, and a management interface controller adapted to selectively output from the frame memory one of the at least three test frames pre-stored in the frame memory as a test signal.

The Office Action concedes that both *Barnard et al.* and *Chang et al.* do not teach generating a test signal by selectively outputting one of the at least three test frames pre-stored in a frame memory as a test signal. Indeed, nothing has been found or pointed to, in either of those references, that would teach or suggest the above features of Claims 1, 10, and 11.

The Office Action asserts that "Purcell et al. ... teach selectively outputting a error/invalid frame or a valid frame as the test signal...", and cites col. 2, lines 23-40, col. 3, lines 6-11, col. 9, lines 1-14, and col. 15, lines 45-56 as support for this assertion. See the sentence bridging pages 3 and 4 of the Office Action. However, those portions of *Purcell et al.* relate merely to enabling a user to create a test message frame via a personal computer. As an example, from col 8, line 60 to col. 9, line 11, *Purcell et al.* states:

When the interface is to be tested, the program advances from step 102 to step 108 where the operator creates a string of control characters representing the message frame for the test. This may be accomplished by the operator selecting the standard protocol header and end delimiter symbol sequences or specifying each symbol of these sequences. Each of the standard symbol sequences is selected by entering a single control code character into the computer instead of entering control characters for each symbol of the sequence. The operator can either specify a control character for each symbol of the data field or instruct the personal computer 18 to generate a specified number of one and zero symbols in a random pattern selected by the computer. By enabling the operator to specify each symbol of the message frame, invalid header, start delimiter and end delimiter symbol, sequences can be specified. This latter technique enables the reaction of the modem 12 and head end 16 to invalid symbol sequences to be examined.

Even if *Purcell et al.* be deemed to refer to an operator selecting a standard protocol header and end delimiter symbol sequences or specifying each symbol of these sequences, nothing has been found or pointed out, in *Purcell et al.* that would teach or suggest a transponder that includes a frame memory pre-stored with at least three predefined test frames, each test frame being an error frame or a valid frame, and that also includes a management interface controller adapted to selectively output from the frame memory one of the at least three test frames pre-stored in the frame memory as a test signal, as set forth in Claims 1, 10, and 11. Indeed, in *Purcell et al.*, user-designated data symbols in a series of data symbols do not necessarily contain predefined sequences of symbols (as explicitly stated in, e.g., col. 15, lines 53-56 of *Purcell et al.*). Moreover, col. 2, lines 11-20 of *Purcell et al.* appears to teach away from using only predefined test messages.

Because neither *Barnard et al.*, *Chang et al.* nor *Purcell et al.* teaches or suggests the above-emphasized features of Claims 1, 10, and 11, even if *Barnard et al.* or *Chang et al.* were to be combined with *Purcell et al.* as suggested in the Office Action (which, in any event, is not admitted as being obvious or technically feasible), the resulting combination still would not teach or suggest those features.

Further, the Office Action in the paragraph bridging pages 3 and 4, concedes that *Purcell et al.* fails to teach or suggest at least three predefined test frames pre-stored in a frame memory, and states, without any documentary support, that the positively recited limitation of having a frame memory pre-stored with at least three predefined test frames is well understood in the art. It is respectfully requested that

documentary evidence be provided to support the foregoing assertion, or else the subject rejection should be withdrawn, because assertions of technical facts in areas of esoteric technology or specific knowledge of the prior art must always be supported by citation to some reference. See M.P.E.P. Sec. 2144.03.

Furthermore, M.P.E.P. Sec. 2144.03 clearly states that in order to establish a *prima facie* case of obviousness against a claimed invention, all features must be taught or suggested by the prior art. Because none of the references relied on in the Office Action to reject Claims 1, 10, and 11 teach or suggest at least three predefined test frames pre-stored in a frame memory, it is respectfully submitted that the Office Action has failed to establish a *prima facie* case of obviousness against those claims.

For the above reasons, Claims 1 and 11 are each believed to be clearly patentable over *Barnard et al.* and *Purcell et al.*, and Claim 10 is believed to be clearly patentable over *Chang et al.* and *Purcell et al.*, whether those references are considered separately or in those respective combinations.

A review of *Fee* has failed to reveal anything that would remedy the above-noted deficiencies of *Barnard et al.* and *Purcell et al.*, whether considered separately or in combination, as references against Claim 11 herein. Accordingly, Claim 11 is believed to be patentable over *Barnard et al.*, *Purcell et al.*, and *Fee*, whether considered separately or in combination.

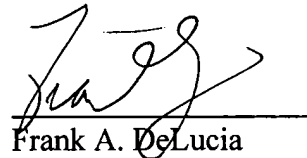
Claim 37 is a method claim corresponding in many relevant respects to Claim 1, and also is believed to be patentable over *Barnard et al.* and *Purcell et al.*, whether considered separately or in combination, for substantially the same reasons as is Claim 1.

Each of the remaining claims depends from one or another of the independent claims discussed above, and also is believed to be patentable over the art relied on in the Office Action, at least for the reason that each depends from a patentable base claim. Nonetheless, since each dependent claim defines an additional aspect of the invention, the independent reconsideration of each on its own merits is respectfully requested.

In view of the foregoing amendments and remarks, favorable reconsideration and early passage to issue of the present application are requested.

Applicants' undersigned attorney may be reached in our New York office by telephone at (212) 218-2100. All correspondence should continue to be directed to our below listed address.

Respectfully submitted,

A handwritten signature in black ink, appearing to read 'Frank A. DeLucia', is written over a horizontal line.

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